

Serial No. 10/690,670

REMARKS

The applicants note with appreciation the acknowledgement of the claim for priority under section 119 and the notice that all of the certified copies of the priority documents have been received.

The applicants acknowledge and appreciate receiving initialed copies of the forms PTO-1449 that were filed on 23 October 2003 and 3 February 2004, respectively.

Claims 35-46 are pending. Claims 1-34 have been canceled. Claim 43-46 are new. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

The office action includes an objection to the incorporation by reference starting on page 1, line 2 of the specification. However, it is respectfully submitted that the incorporation by reference is proper. Essential subject matter is not being incorporated by reference, since the present English version of the priority Japanese application is believed to be complete and is believed to include all essential subject matter. The Japanese priority document is being incorporated by reference to enable translation errors that may be discovered during prosecution to be corrected without entering new matter during prosecution of the present application.

Applicant's position on this issue is supported by the following reasoning: Where a foreign priority document under 35 U.S.C. §119 is of record in the U.S. application file, applicant may not rely on the disclosure of the document to support correction of an error in the pending U.S. application. *Ex parte Bondiou*, 132 U.S.P.Q. 356 (Bd. App. 1961). This prohibition applies regardless of the language of the foreign priority documents because a claim for priority is simply a claim for the benefit of an earlier filing date for subject matter that is

common to two or more applications, and does not serve to incorporate the content of the priority document in the application in which the claim for priority is made. However, this prohibition does not apply where the US application explicitly incorporates the foreign priority document by reference. Therefore, the applicants are attempting to avoid the prohibition described above.

Since no material known to be essential at this time is being incorporated by reference, no amendment of the specification should be required, and there is no reason why the statement of incorporation must be removed. Therefore, the applicants respectfully request the withdrawal of the objection to the specification.

The title was objected to as being non-descriptive. The title has been amended to be more descriptive. Therefore, the applicants respectfully request withdrawal of this objection.

Minor clarifications have been made in the claims. The term "input means" has been changed to "input rotor" to indicate that the claims are not considered to be means plus function claims under section 112, paragraph 6. Further, the phrase "composite type compressor" has been removed from the claims. These changes are clarifications and not in response to any rejection.

Claims 35-42 were objected to because of the term "and/or." This term has been removed from claim 35 and replaced with the word "and." Therefore, the applicants respectfully request that this objection be withdrawn.

Claims 35-42 were rejected under 35 USC 103(a) as being unpatentable over Irie *et al.* in view of Kawamura. The applicants respectfully request that this rejection be withdrawn for the following reasons.

Both Irie *et al.* and Kawamura disclose three rotary members that are driven integrally. That is, in Irie *et al.*, a shaft of an engine 1, a pulley of the motor 2, and the shaft 11 of a

compressor 10 are driven together by a belt. In Kawamura, a turbine 22, a motor-generator 3, and a compressor 21 are driven integrally by a common shaft 23. Therefore, the rotational speed of one of the three members cannot be changed independently of the others. However, in the present invention, the rotational speed of the compressor can be increased or decreased by operating the dynamotor as either a motor or a generator without changing the speed of the input rotor.

In particular, claim 35 recites, among other things, the following:

... wherein the control unit supplies power to the dynamotor, at a time when the dynamotor functions as a motor, to increase the rotational speed of the compressor while maintaining the rotational speed of the input rotor, wherein the dynamotor alternatively functions as a generator to decrease the rotational speed of the compressor while maintaining the speed of the input rotor.

Neither of the references to Irie *et al.* or Kawamura can perform this function because the various rotary devices rotate integrally, not independently. Therefore, even if the devices of Irie *et al.* and Kawamura are combined, the resulting device cannot satisfy the terms of claim 35. Claims 36-42 depend, directly or indirectly, on claim 35. Thus, claims 36-42 are considered to be patentable for the reasons given above for the patentability of claim 35. Therefore, the applicants respectfully request that the rejection of claims 35-42 be withdrawn.

Claims 43 and 44 are new. Claims 43 and 44 depend on claim 35 and are thus considered to be patentable for the reasons given above.

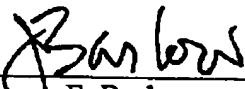
Claims 45 and 46 are new method claims. Independent claim 45 recites language similar to that of claim 35. Therefore, claims 45 and 46 are considered to be patentable over the combination of Irie *et al.* and Kawamura for the reasons given above with respect to claim 35.

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In view of the foregoing, the applicants respectfully submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,

  
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